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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,000	04/26/2001	Frank Charles Pagano	Rev 98-25	7885
26807	7590	11/01/2004	EXAMINER	
JULIE BLACKBURN REVLON CONSUMER PRODUCTS CORPORATION 237 PARK AVENUE NEW YORK, NY 10017			GOLLAMUDI, SHARMILA S	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/843,000

Applicant(s)

PAGANO ET AL.

Examiner

Sharmila S. Gollamudi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/9/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 21-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

Receipt of Amendments and Remarks received August 9, 2004 is acknowledged. Claims **1-19** and **21-36** are pending in this application. Claim 20 stands cancelled.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-10, 14, 21-23, and 31-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Perronin et al (3,991,007).

Perronin discloses the preparation of pigmentary particles coated with an organic polymer. Perronin discusses the importance of pigments in many fields such as cosmetics. Note column 1, lines 10-12. Example 6 provides a composition with 100 parts a pigment, 350 parts heptane, 90 parts methyl methacrylate, and 10 parts acrylic acid. The methacrylate-acrylic acid copolymer is 70-30. The pigment composition D is then combined in an amount of 190 parts (50% pigment and 50% instant copolymer) with 86 parts nitrocellulose resin, 210 parts ethyl acetate, 22 parts butanol, 155 parts isopropanol, and 28 parts butyl phthalate (plasticizer). Example 13 teaches a copolymer of methyl methacrylate and acrylic acid in the amount of 80-20. Suitable solvents include ethers and esters. See column 2, lines 60-62.

Note that the preamble “nail enamel composition” does not hold since it does not denote any structural limitation to the composition itself.

Response to Arguments

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Applicant's arguments filed 8/9/04 have been fully considered but they are not persuasive.

Applicant argues that the examiner concedes: 1) a composition capable of forming a film on a nail 2) a composition with instant glass temperature 3) instant 2 to 29% of a polar monomer 3) a composition with the instant intended use of the solvent.

It should be noted in the previous response that the examiner states this was *applicant's* position and not the examiner's.

Applicant argues that that numerous patents have been granted wherein the preamble has been given weight.

In response to these arguments, the examiner points out that the prosecution of other applications is irrelevant and the examiner is only concerned with the patentability of the instant application. The examiner again points out that the preamble is only given weight if it provides a structural limitation. If applicant purports that Perronin cannot form a film on a nail, the examiner suggest that the applicant provides a Rule 132 declaration providing evidence to overcome Perronin.

Applicant argues that Perronin does not teach the instant glass transition.

It is the examiner's position that since the copolymer is the same and in the same range as seen in example 6, then it would inherently have the same glass transition temperature. If applicant contends otherwise, it is the applicant's burden to provide evidence showing that the prior art does not have the same glass transition.

Therefore, the rejection is maintained.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The rejection of claims 1-14, 21-26, and 33-34 under 35 U.S.C. 102(e) as being anticipated by Bednarek et al (6,254,878) is maintained.

Bednarek et al disclose a nail polish composition containing acrylic polymers. The composition comprises a solvent system having no more than 30% water, 0.1-30% of a pigment, a film forming acrylic binder prepared from methacrylic monomer, and styrene and which further contains adhesion promoting monomers. See abstract. Example 1 discloses titanium dioxide or red iron oxide pigment (pigment), 0.1-15% bentonite clay (suspending agent), 3-10% dibutylphthalate plasticizer, butyl acetate solvent, and 40% acrylic polymer (20/70/10 wt. % butylmethacrylate-co-methacrylate-co-acrylic acid). Various copolymers are taught comprising the instant monomers. The reference discloses the use of 0.1-20% of silicone glycol copolymer. See column 9, lines 5-7.

Response to Amendment/Arguments

The applicant argues that the examiner has not considered the Rule 131 declaration in that it teaches BMA/AA (90-10), a solvent, and a plasticizer. Applicant argues that Bednarek teaches butylmethacrylate-co-methacrylate-co-acrylic acid and the instant claims 27-36 have closed claim language.

The Affidavit filed on January 29, 204 under 37 CFR 1.131 is insufficient to overcome the Bednarek et al (6,254,878) for the following reasons:

The Affidavit does not establish that the inventor had the teaching prior to the cited reference. The examiner points out that the prior art utilizes butylmethacrylate-co-methacrylate-

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co-acrylic acid and the Rule 131 utilizes BMA/AA which are different polymers as recognized by the applicant. Moreover, Bednarek's composition contains a pigment and dispersant, which are not shown in applicant's Rule 131. Thus, the Rule 131 is directed to a different invention than Bednarek's. Therefore, the Rule 131 affidavit is not persuasive to overcome US patent 6,254,878 to Bednarek et al as a 102(e) reference.

With regard to claims 27-36, the examiner points out that these claims are not included in the anticipatory reference and thus this argument is moot.

Therefore, for the reasons above, the rejection is maintained.

The rejection of claims 1-8, 14-16, 21-23, and 33 under 35 U.S.C. 102(b) as being anticipated by Chen et al (5,571,603) is withdrawn in view of applicant's amendment reciting "an anhydrous nail composition".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The rejection of claims 15-16 and 27-32 under 35 U.S.C. 103(a) as being unpatentable over Bednarek et al (6,254,878) is maintained.

As set forth, Bednarek et al disclose a nail polish composition containing acrylic polymers. The composition can comprise water in the solvent system of no more than 30% water. See abstract. Instant plasticizers are taught as conventional additives for nail polish compositions on column 8, lines 51-65. Silicone copolymers are taught in the amount of 0.1-20%. See column 9. Bednarek teaches the use of non-acrylic binders such as cellulosic film formers (nitrocellulose) for gloss and hardness. See column 6, line 30.

Bednarek et al do not exemplify the instant plasticizer, a silicone glycol copolymer, or nitrocellulose.

It is deemed obvious to one of ordinary skill in the art at the time the invention was made to include the instant additives in the composition of Bednarek. One would have been motivated to do so since Bednarek teaches the instant additives are suitable in the nail composition. Bednarek teaches the use of plasticizers in the art is conventional and many are known in the art. Therefore, one would have been motivated to use the instant plasticizer with the expectation of similar results. One would have been motivated to add nitrocellulose in the composition act as an auxiliary agent to increase gloss and hardness as taught by the reference. Therefore, with the guidance of the prior art it is deemed obvious to add the instant additives to yield the instant formulation.

In regards to claims 27-32, it is deemed obvious to one of ordinary skill in the art at the time the invention was made to look to the guidance of Bednarek et al and utilize the instant monomer combination. One would have been motivated to do so through routine

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experimentation to obtain the best possible results since Bednarek teach a variety of monomer combinations with the criticality lying in that the binder is an acrylic copolymer and not the monomer combination itself. It is the position of the examiner that a combination of two ethylenically unsaturated monomers and polar monomer would not have an adverse effect in the nail composition. It is noted further that applicant's claims also allow for the combination of two ethylenically unsaturated monomers and a polar monomer such as Bednarek's butylmethacrylate-co-methylmethacrylate-co-acrylic acid, which substantiates the examiner's position that this combination does not have an adverse effect in the nail composition.

Therefore, absent the unexpectedness of the instant copolymer consisting of only one nonpolar ethylenically unsaturated monomer and a polar monomer compared to the prior art's copolymer consisting of two nonpolar ethylenically unsaturated monomers and a polar monomer, this is deemed an obvious parameter for a skilled artisan to include or exclude monomers in a copolymer composition to obtain the desired effect.

Response to Arguments

Applicant argues that Bednarek is removed because applicant has an effective date prior to Bednarek's.

The examiner has addressed the Rule 131 declaration above.

The rejection of claims 17-19 and 35-36 under 35 U.S.C. 103(a) as being unpatentable over Bednarek et al (6,254,878) in view of Pagano et al (5,772,988) is maintained.

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As set forth, Bednarek et al disclose a nail polish composition containing acrylic polymers. Bednarek teaches that the nail composition matches the ability of nitrocellulose in its resistance to cracking, fading, chipping, and peeling. See column 1, lines 35-43.

Bednarek does not teach a kit system with nitrocellulose in a different container.

Pagano et al disclose a nail composition containing butyl acetate, a copolymer with a polar monomer (acrylic acid) and a nonpolar ethylenically unsaturated monomer, pigments, a suspending agent (stearalkonium bentonite), silicone glycol copolymer, and a plasticizer (glyceryl tribenzoate) (Note examples). Monomer A (ethylenically unsaturated monomer) is in the amount of 30-95%, monomer B (acetoacetoxy moieties) in the amount of 5-50%, and monomer C (acrylic acid) in the amount of 1-20%. Note column 5, lines 24-29. Further, Pagano teaches an aqueous nail enamel composition (Note example 8). The kit contains the polymer composition in container 1 with a cellulose polymer (nitrocellulose) and solvent in container 2. The cellulose film-former provides excellent wear characteristics and is applied as a basecoat and topcoat. The polymer composition is applied as the middle layer. See column 9.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Bednarek et al and Pagano et al and utilize a kit with a cellulose film-former in conjunction with Bednarek's polymer composition. One would be motivated to do so since Pagano teaches the cellulose-film former improves the wear characteristics of the nail polish. Further, Bednarek teaches the use of cellulose film-formers for the same function. Therefore, one would be motivated to utilize a kit formulation with the expectation of similar results.

Response to Arguments

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Applicant's arguments filed 8/9/04 have been fully considered but they are not persuasive.

Applicant argues it is unclear how a rejection can be made wherein Pagano is utilized as the secondary reference since Pagano teaches the use of AAEMA and the instant invention does not.

The examiner points out that the secondary reference is only relied upon to teach a kit packaging and not for the instant polymer composition since the primary reference already teaches the instant polymer. The examiner relies on Pagano to teach the cellulose film former in a different container to provide long wear characteristics when utilized as a basecoat or topcoat. Therefore, the rejection is maintained.

Conclusion

All the claims remain rejected at this time.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

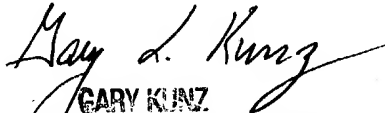
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sharmila S. Gollamudi
Examiner
Art Unit 1616

SSG


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